

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NIRA SCHWARTZ, ARIE SHAHAR  
and RICHARD WOODS

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Appeal No. 1998-0632  
Application 08/301,812

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ON BRIEF

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Before THOMAS, KRASS and LALL, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 45 through 53, which constitute all the claims remaining in the application.

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Representative claim 45 is reproduced below:

45. A method for monitoring an action station on a production line where containers which contain liquid pass through said action station and experience a force which causes said liquid to be in a dynamic state, comprising:

(a) causing a plurality of containers which contain liquid to pass through said action station sequentially,

(b) operating on each container at said action station so that said liquid in each container is in a dynamic state when each container leaves said action station and so that said dynamic state asymptotically approaches a final level after each container leaves said action station,

(c) inspecting optically at several successive times the liquid level in each of said containers to obtain several liquid levels for each of said containers as said dynamic state asymptotically approaches said final level and saving said liquid levels for each of said containers as a plurality of saved liquid levels, and

(d) analyzing said saved liquid levels in order to monitor said action station and predict future final liquid level.

There no references relied upon by the examiner.

The claims on appeal appear to be rejected under both the enablement and the written description portions of 35 U.S.C. § 112, first paragraph.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

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OPINION

Our consideration of the brief and reply brief along with the answer leads us to conclude that there appears not to have been a meeting of the minds as to the nature of the issues involved on appeal. To the extent appellants may have been prejudiced by this, the entry of the reply brief appears to have cured such a possibility. To simplify our consideration here, however, having considered the views expressed in the answer, which make reference to the first office action and, by implication, the final rejection, we construe the issues as involving both enablement and written description rejections under the first paragraph of 35 U.S.C. § 112 as applied to the claimed action station (claims 45 through 53), the prediction feature (claims 45 through 50) and the correlation feature (claims 51 through 53). This rather complicated situation presents the most comprehensive view to us of the issues on appeal. In any event, we reverse the rejection of each of them as explained herein.

At the outset we note that the examiner's reasoning for lack of "support" for the claimed invention herein implicitly

refers

to the written description portion of this statutory provision.

In re Higbee, 527 F.2d 1405, 1406, 188 USPQ 488, 489 (CCPA 1976).

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of later claimed subject matter. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117, (Fed. Cir. 1991).

Appellants' specification as filed makes reference to their prior application, which has matured into U.S. Patent 5,414,778 issued on May 9, 1995. The discussion of prior art Figure 1 in this application comprises the Figure 2 showing in this prior patent. There is no disclosure of the claimed so-called "action station" in the parent application. As indicated at the bottom of page 3 of the principal brief on appeal, the present specification differs from the parent

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application and patent by teaching that the action station may comprise other actions upon the containers along the conveyor belt other than the previously disclosed filling station-type of action in appellants' preceding patent. The top of page 6 of the brief indicates that the

presented claims here are broader than the claims in the parent patent and that they recite that an action station creates a dynamic state.

The filing of the second terminal disclaimer by appellants as the second advisory action in the application file so indicates appears to obviate the concerns of the examiner with respect to the broader interpretation that may be attributed to the present claims on appeal.<sup>1</sup> As it is clear from the present specification as filed, appellants do not intend and they are not therefore entitled anyway to the effective filing date of their parent application/patent.

In light of the above-noted precedent, there is no question that the present application on its filing date provides adequate support within the written description portion of 35 U.S.C.

§ 112, first paragraph, for the presently claimed subject matter of an "action station" in each pending claim on appeal. Therefore, to the extent the examiner's rejection may be interpreted as asserting there is no support for the claimed

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<sup>1</sup> The record does not reflect, however, that the terminal disclaimer has been appropriately recorded.

invention as to this feature, it is reversed. Plainly, appellants had possession of that feature as disclosed in Figure 2 of the present application and the lengthy discussion with respect thereto in the specification itself. The detailed discussion of the action station begins at the bottom page 10 of the specification as filed.

To the extent of the written description rejection relates to the correlation and prediction features of the earlier noted claims on appeal, we reverse this rejection as well. The prediction feature is noted at the following locations in the specification as filed: the middle of page 2; the top half of page 3; the top of page 10; the of page 13; the top of page 16; and another summary of the invention at the end of this specification at page 30. Similarly, the correlation function in the earlier noted claims on appeal has been mentioned and discussed at the following pages of the specification as filed: the objects of the invention at pages 3 through 5; the general summary of the invention at pages 6 and 7; the top of page 8; the middle of page 10; the middle page of 11; the top and bottom of page 12; the top half of



page 16; the comparison discussion at the bottom half of page 23 and the summary of the invention at the end of the specification at page 30. Additionally, as to this correlation feature, the latter half of the abstract at page 42 of the specification as filed relates to various types of feedback information which are derived as a function of correlated data during the inspection operations set forth earlier in the abstract.

Thus, it would have been readily appreciated by the artisan that appellants have presently disclosed in this application a written description of the action station claimed, and the claimed correlation and prediction features. Therefore, all rejections under the written description portion of the first paragraph of 35 U.S.C. § 112 as to these features are reversed.

As to the enablement issue, the specification of the patent must teach those skilled in the art how to make and use the claimed invention without undue experimentation.

Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir.), cert. denied, 118 S. Ct. 397

(1997). This same case indicates that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the disclosure. Enablement is also not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly excessive.

Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert denied, 480 U.S. 947 (1987).

In the context of the just-noted portions of this specification as filed supporting the claimed features of the action station and the correlation and prediction features, we presently view these in light of an enablement question, further in light of the just-noted legal standards and conclude that the rejection thereof must also be reversed. The claimed action station includes the capability as disclosed of performing a filling action, which was not questioned by the examiner in the previous application. The pasteurization, heating, shaking and gas injection features are in our judgment well known processes in the art anyway as

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appellants assert at least at page 3 of the principal brief on appeal. The nature of the entire specification and drawings as filed is to teach reasonably so, in our view, to the artisan the ability of the image processor station 30 to ascertain various dynamic states associated with each of these type of parameters which are well known anyway to determine an end result of a liquid level or a bubble level as set forth in various claims on appeal. The action station of the claims is also characterized as a force creating station for producing a fluid in a dynamic state in accordance with a brief description of Figure 2 at page 5 of the specification as filed.

The examiner's concerns with respect to the phrase "action units" is misplaced as well because such term is defined at page 11 of the specification as filed at lines 14 and 15 by giving examples of them, such as nozzle or heating pads inside the action station itself. Because bottle sensor 103 and bottle sensor 108 and prior Figure 1 senses the bottle positions during filling and after filling respectively, it is possible from the image processor analysis to identify a given fill nozzle 104, for example, as being one which over or under fills the containers 109. This concept is related to the correlation and the predicating functions of the claims on appeal and otherwise generally expressed in the specification as filed as a monitoring and feedback control for the process control of the claimed production line as set forth, for example, at the end of representative claim 51 on appeal. An object of the invention as expressed at page 3 is to basically correlate a malfunctioning unit with inspected containers for quality and process control purposes. An additional object at the bottom of page 4 and at the top of page 5 of the specification as filed is "to correlate a fill nozzle on a

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filling carousel with an inspected container

for easy nozzle adjustment for the right amount of fluid and bubbles inside a container, thereby to provide an automatic alarm if one of the nozzles on the carousel is off calibration." Also as noted in the objects at page 4 of the specification as filed, the system permits a prediction of the final fluid level and the amount of dissolved gasses in containers while they move on a production line as well as to predict a liquid's viscosity as a function of the rate bubbles in the liquid are dissolving.

Appellants' specification relies upon their own prior patent in part to provide some of the methodologies in which these processing actions are effected. The specification also makes mention, such as at page 9, of another prior patent U.S. 5,204,911, issued on April 20, 1993, as well as a prior art image procesor for embodying the image processor 213 in Figure 2. Our study of this specification and drawings as filed leads us to conclude that the examiner has not provided a sufficient basis within 35 U.S.C. § 112, paragraph one, to question the adequacy of the disclosure as a whole, such that it would require the artisan undue amounts of experimentation

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to make and use the claimed invention as it relates to the action station and correlation and prediction functions. It appears to us that only a reasonable degree of experimentation would have been necessary to make and use the claimed invention as to these features. Therefore, we reverse the rejection of claims 45 through 53 on appeal to the extent that it relates to the enablement portion of 35 U.S.C. § 112, first paragraph.

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In view of the foregoing, we reverse all of the  
examiner's apparent rejections of claims 45 through 53 on  
appeal under the first paragraph of 35 U.S.C. § 112.  
Therefore, the decision of the examiner is reversed.

REVERSED

	JAMES D. THOMAS	)	
	Administrative Patent Judge	)	
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		)	BOARD OF PATENT
	ERROL A. KRASS	)	APPEALS
	Administrative Patent Judge	)	AND
		)	
INTERFERENCES		)	
		)	
		)	
	PARSHOTAM S. LALL	)	
	Administrative Patent Judge	)	



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